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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,288	09/11/2003	Michael Zung	6771USP4	5342

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EXAMINER
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ANDERSEN, MICHAEL T

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/660,288

Applicant(s)

ZUNG ET AL.

Examiner

M. Thomas Andersen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Applicant's amendments to the specification have corrected the subject matter pertaining to the reference numeral objections in the first office action. Accordingly, the objections to the drawings are now withdrawn.

### ***Response to Arguments***

2. Applicant's arguments filed December 14, 2005 have been fully considered but they are not persuasive.

3. Applicant argues that the Violante instrument housing (150) lack limitations found in the claim language. This is true, however, examiner is interpreting the Violante needle protector (170) as the housing in regards to the present claims. The needle protector (170), given the broadest reasonable interpretation of the claims, does in fact read on the claims of the present invention. So interpreted from the Violante reference, housing (170) contains a shaft (172) and a needle (164) that is movable within shaft (172) and the needle (164) may be moved independently relative to the housing (170). Further the housing (170) has a cutting blade (176) positioned on it for cutting the suture. Using such a broadest reasonable interpretation, Violante does in fact read on the present claim language.

***Claim Rejections - 35 USC § 102***

4. **Claims 1,3, 5, 7, 11-14, 16 and 18** are rejected under 35 U.S.C. 102(b) as being anticipated by Violante (U.S. 3,840,017).

Regarding **claim 1**, Violante discloses a housing (170), a needle (164) movable with respect to the housing (column 3, line 33-column 4, line 3), the needle being attached to a length of suture (160), and a suture cutting blade (176) positioned on the device such that when the needle is withdrawn from the device, the suture can be drawn across the blade to sever the suture (see Figs. 13-15).

Regarding **claim 2**, Violante discloses the blade (176) being mounted on the housing (170) (see Figs. 13-15).

Regarding **claim 3**, Violante discloses the housing (170) having a distal end (near cross-section 14) and a proximal end (near cross-section 15), and the blade (176) being positioned near the distal end (see Fig. 13).

Regarding **claim 5**, Violante discloses the needle (164) and the suture (160) being withdrawn from the proximal end (near cross-section 15) of the housing (170) (see Fig. 13; and column 3, line 33-column 4, line 3).

Regarding **claim 7**, Violante discloses the blade (176) being mounted on the outside of the housing (170) (see Figs. 13-15).

Regarding **claim 11**, Violante discloses the needle (164) having a distal end (see tip of needle 164) and the suture (160) being attached to the distal end of the needle (see Fig. 13).

Regarding **claim 12**, Violante discloses a housing (170) having a proximal end (near cross-section 15) and a distal end (near cross-section 14); a suture cutting blade (176) positioned on the housing; an elongate shaft (172) extending from the distal end of the housing, the elongate shaft having a distal end region (near cross-section 14); a needle actuation handle (157) movable through the proximal end of the housing (174 movable through proximal end of 170); a needle (164) extending from the needle actuation handle (157), through the housing (170) and further through the shaft (172); and a suture (160) carried by the device, wherein a portion of the suture (160) is positioned near the distal end region (near cross-section 14) of the shaft (172) such that the needle (176) pulls the suture (160) proximally to position the suture through tissue.

Regarding **claim 13**, Violante discloses the blade (176) being positioned near the distal end (near cross-section 14) of the housing (170) (see Fig. 13).

Regarding **claim 14**, Violante discloses the needle (164) pulling the suture (160) through the proximal end (near cross-section 15) of the housing (170) (see Fig. 13; and column 3, line 33-column 4, line 3).

Regarding **claim 16**, Violante discloses the needle (164) and the suture (160) being withdrawn from the proximal end (near cross-section 15) of the housing (170) (see Fig. 13; and column 3, line 33-column 4, line 3).

Regarding **claim 18**, Violante discloses the blade (176) being mounted on the outside of the housing (170) (see Figs. 13-15).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 4, 6, 8-10, 15, 17, 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Violante in view of Ogburn (U.S. RE 22,857).

Violante discloses the invention substantially as claimed, including a removable housing (170) that will be handled and gripped by the operator's fingers when it is moved both onto and off of the body (157) of the surgical instrument. Violante does not disclose the blade being positioned in the distal opening (opening of bore (172) near cross-section 14), near the proximal end of the housing, on the inner surface (172) of the hollow housing, on a finger grip (170), or on a movable handle (170).

However, *In re Japikse*, held that claims that read on the prior art except with regard to the position of a claimed element were held unpatentable if shifting the position of the claimed element would not have modified the operation of the device. 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). Simple relocation of the suture-cutting blade does not modify the operation of the claimed device, but merely relocates the location of drawing the suture across the blade.

Furthermore, Ogburn discloses that it is old and well known in the art to use a stationary suture cutting blade on the housing of a medical suturing device for the purpose of severing the suture after it has been applied to the wound (column 1, lines 29-32; column 2, lines 11-13; and column 4, lines 3-10; see Figs. 1-3 and 11-13, reference numerals 51-54). Therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to use a stationary suture cutting blade on the housing of the device of Violante, in order to gain the advantage of being able to sever the suture after it has been applied to the wound, as taught by Ogburn.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Lynch whose telephone number is (571) 272-6465. The examiner can normally be reached on Monday-Friday 8AM to 5PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RL

  
ANH TUAN T. NGUYEN  
SUPERVISORY PATENT EXAMINER

3/3/06